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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,908	03/01/2000	Shmuel Shaffer	00P7493US	3123

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Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

HU, JINSONG

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/516,908

Applicant(s)

SHAFFER ET AL.

Examiner

Jinsong Hu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-4 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Mogul et al. (US 6,243,761 B1).

4. As per claim 1, Mogul teaches the invention substantially as claimed including a method for providing data files to a remote user over a channel [col. 1, lines 9-13] comprising:

determining the speed of a channel, estimating the transfer time for a data file [col. 4, lines 28-30]; responsive to said transfer time, determining whether to transfer said data file or a compressed version of the data file [col. 5, lines 50-57; col. 7, line 66]

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– col. 8, line 4]; and transferring said data file or a compressed version of said data file based on determining [col. 5, lines 58-67].

5. As per claim 3, Mogul teaches the step of determining the speed of a channel when received user's downloading requesting [col. 4, lines 15-23].

6. As per claim 4, Mogul teaches that the data files include at least one file of at least one file type from the group consisting of digitally encoded audio files, digitally encoded video files, digitally encoded text, and digitally encoded images [col. 4, lines 7-8; col. 5, lines 8-11].

7. As per claim 8, Mogul teaches the step of transmitting to a user system data representing a list indicating available data files, indicating estimated transfer times for said data files and for compressed versions of a data file, and receiving a user selection of a data file indicating a desired transfer delay [col. 5, lines 57-67].

8. As per claims 9-11, Mogul teaches the step of comparing the transferring time with a threshold and converting a file to another format if the transferring time exceeds a threshold [col. 5, lines 47-57; col. 10, lines 23-27].

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul et al. (US 6,243,761 B1) applied to claims 1 above, in view of Barrett et al. (US 5,908,467).

11. As per claims 2 and 5, Mogul teaches the invention substantially as claimed in claim 1. Additionally, Mogul teaches the step of determining the speed of the channel [col. 6, line 49 – col. 7, line 6; col. 8, lines 63-67]. Mogul does not specifically teach the step of sending a test on the channel.

12. Barrett on the other hand teaches the step of sending a test on the channel [22, Fig. 3; col. 4, lines 5-12]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Mogul and Barrett because doing so would improve the management of the system by obtaining more accurate transfer speed which used as the criteria of compression. One of ordinary skill in the art would have been motivated to modify Mogul with Barrett's test step to improve the performance of the system.

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13. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogul et al. (US 6,243,761 B1) applied to claims 1 above, in view of Bentley et al. "The freedom to choose: Transforming content on-demand in the BSCW shared Workspace system (hereinafter as BSCW)", Germany Research center for computer science, 1997.

14. BSCW is a prior art reference cited by the Applicant on 1449, file on 8/30/00.

15. As per claims 6-7, Mogul teaches the invention substantially as claimed in claim 1. Mogul does not specifically teach the step of receiving an indication from a user as to what compression format are decodable by the use system and sending the relevant applet to user for accessing the compressed file.

16. However, BSCW on the other hand teaches the step of receiving an indication from a user as to what compression format are decodable by the user system and sending the relevant applet to user for accessing the compressed file [col. 5, second paragraph]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to including BSCW's format selecting step in Mogul's system because doing so would improve the dynamic of the system by allowing the clients selecting the formats they prefer. One of ordinary skill in the art would have been motivated to modify Mogul's system with BSCW's selecting step to benefit users.

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17. Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 5,908,467) in view of Bentley et al. "The freedom to choose: Transforming content on-demand in the BSCW shared Workspace system (hereinafter as BSCW)", Germany Research center for computer science, 1997.

18. As per claims 12 and 15-16, Barrett teaches the invention substantially as claimed including a method for providing remotely accessible multimedia messages [col. 2, lines 15-25] comprising:

determining the speed of a channel, determining the transfer time for available messages and attachments using the size of available messages and attachments and said speed providing data representing a list of available messages to a user [col. 3, line 61 – col. 4, line 12; col. 5, line 64 – col. 6, line 2; col. 6, lines 10-15].

19. Barrett does not specifically teach the steps of providing format option to user and receiving data from the user for indicating a desired compression option.

20. However, BSCW on the other hand teaches the steps of providing format option to user and receiving data from the user for indicating a desired compression option [col. 5, second paragraph]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Barrett and BSCW because adding BSCW's format selecting step in Barrett's would improve the dynamic of Barrett's system by allowing the clients selecting the formats they prefer.

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One of ordinary skill in the art would have been motivated to modify Barrett's system with BSCW's selecting step to attract more users.

21. As per claim 13, Barrett teaches the step of sending a test on said channel and detecting the transfer time of said test on said channel [col. 4, lines 5-12].

22. As per claim 14, Barrett teaches that the data files include at least one file of at least one file type from the group consisting of digitally encoded audio files, digitally encoded video files, digitally encoded text, and digitally encoded images [col. 1, lines 39-40; col. 3, line 21].

23. As per claims 17-19, since they are apparatus claims of claims 12-13 and 15, they are rejected for the same basis as claims 12-13 and 15 above.

24. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett et al. (US 5,908,467).

25. As per claim 20, Barrett teaches the invention substantially as claimed including a method for presenting to a user a list of messages for interacting with a multimedia message server comprising:

presenting to a user an identification of a message available for transfer,
presenting an indication of a transfer time indicating time for transferring of a message

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[col. 3, line 61 – col. 4, line 12; col. 5, line 64 – col. 6, line 2] and registering a user action indicating a compression option to be transferred [col. 10, lines 26-27].

26. Barrett does not specifically teach presenting a transfer time for a compressed message to user. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to present transfer time for compressed version in Barrett's system because doing so will bring convenience to users by allowing them make a selection based on their need [col. 8, lines 56 – col. 9, line 6]. One of ordinary skill in the art would have been motivated to modify Barrett's system for attracting more users.

Conclusion

27. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (703) 305-9678. The fax number for this Group is (703) 308-9052. Additionally, the fax numbers for Group 2100 are as follow:

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Official Faxes: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

June 13, 2003


ZARNI MAUNG
PRIMARY EXAMINER